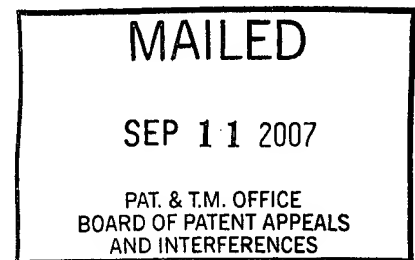


1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
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10 Ex parte LAURENCE J. BOOTON and CHARLES R. CARRINGTON
11

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13 Appeal 2007-2434
14 Application 09/936,220
15 Technology Center 2600
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18 Oral Hearing Held: August 7, 2007
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22 Before ALLEN R. MacDONALD, JAY P. LUCAS, and
23 JOHN A. JEFFERY, Administrative Patent Judges
24

25 ON BEHALF OF THE APPELLANTS:
26

27 LARRY S. NIXON, ESQ.
28 NIXON & VANDERHYE, PC
29 901 North Glebe Road
30 Arlington, VA 22203
31

32 The above-entitled matter came on for hearing on Tuesday, August 7,
33 2007, commencing at 10:55 a.m., at the U.S. Patent and Trademark Office,
34 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Jan Jablonsky,
35 Notary Public.

36 MR. NIXON: Good morning, Your Honor.

37 JUDGE MacDONALD: Good morning.

1 JUDGE LUCAS: Good morning.

2 JUDGE MacDONALD: I am assuming you have actually been here
3 before for hearings, and you know that you have 20 minutes and you can use
4 that clock once you start.

5 MR. NIXON: All right. And if there is an easel around that would be
6 great. Otherwise, I can maybe try to make do with my briefcase.

7 JUDGE MacDONALD: Well, I am assuming that you are
8 using -- these are the drawings?

9 MR. NIXON: They are. They have additional labels on them now,
10 which I should have put on earlier. And they have some coloring and marks.

11 JUDGE MacDONALD: Well, I think we are probably fine. We have
12 electronic displays of the drawings available to us, so we should be fine.

13 MR. NIXON: All right. Could I pass out, then, a hand copy--

14 JUDGE MacDONALD: Oh, yes. You may.

15 MR. NIXON: --of those?

16 JUDGE MacDONALD: Yes, you may.

17 MR. NIXON: Great. These are the charts.

18 JUDGE MacDONALD: Thank you.

19 MR. NIXON: And there's one here for the record, as well, if you
20 want.

21 JUDGE MacDONALD: Oh, no. We're fine.

22 MR. NIXON: Okay. Well, I thought I would start. There seems to
23 be some confusion as to what we have claimed and what we haven't claimed.

24 So, I thought I would start with Figure 1 to point out the hardware that
25 is involved. This is a -- there is a CTI server, a computer telephony
26 integrated server, and a PBX. The server is connected to a computer at each

1 workstation, which is called a client 30, and there is a telephone at each
2 station, 28, and that is connected to the PBX.

3 There is also a remote connection that can be made through an ISDN
4 network, for example, 14. And the thrust of the invention here is to keep
5 track of where a person is located with respect to a workstation.

6 So they can always get the phone, incoming calls, for example, to that
7 person, even if that person is logged onto a different workstation than usual.
8 So, this is not the usual situation where somebody has a cubicle assigned to
9 them and the telephone number that is assigned to them is a certain
10 extension number and you know that's where they are supposed to always
11 be.

12 This is -- I'm sorry?

13 JUDGE MacDONALD: Let me stop you there for a second. It
14 sounds like you are describing the secondary aspect of the invention, which
15 is the -- returning phone calls when someone is at a different location
16 because the system has tracked an outgoing call from them and recorded that
17 location so now they can be called back.

18 But the primary invention that was -- I saw disclosed was the first
19 part. You have moved to a different location in your office and you are now
20 placing an outgoing phone call and it detects where you are and does the
21 adjustments. And that appears to be, when looking through the claims,
22 that's -- all I see in the claims are steps directed to that side of what is
23 disclosed.

24 And the only thing I can find directed to what you have specified as
25 the invention and discussed in the brief, also, is those last three and a half
26 lines of claim 1.

1 MR. NIXON: Well, I think it is addressed in some of the dependent
2 claims as well.

3 But let's go, then, to the figures, which show exactly that happens, and
4 I will try to relate that to the claim language in claim 1.

5 There are three elements in claim 1. It is a method claim. And the
6 first element requires responding to a request for the making of the call by
7 obtaining an actual calling party identity. So, on the chart that you see there
8 in blue, there's Table 54B, explaining what happens at the local workstations
9 and then I'll explain what happens when there is a remote station.

10 The first table, 54B, is dynamically updated with respect to the real
11 identity of the person that is logged in to each computer port. So, the IP
12 addresses that you see on the left hand side of Table 54B correspond to a
13 real identity of a person with names on the right side in 54B.

14 So, when a call is being made and it is associated with that particular
15 IP address and translated immediately to the actual calling party identity,
16 which in this case, I have chosen to make that "Bob" -- that's the first step.
17 We find Bob.

18 The second step of claim 1 is translating the obtained actual calling
19 party identity to obtain a corresponding simulated consistent calling line
20 identity, permanently associated with the calling party.

21 That takes place with the third table, which is 54C -- it's actually the
22 second table in this assembly of figures. In that particular one we use the
23 real name, Bob, and you look up a simulated, consistent CLI, which in this
24 case ends with the numbers 800800. So that is taking place in the second
25 step.

1 The third step is that we send a set-up signaling message for
2 establishing a call to the calling party. The set-up signaling message, having
3 a calling line identity field, containing the obtained corresponding simulated
4 consisted calling line identity, in this case, the 800800.

5 The simulated consistent calling line --

6 JUDGE MacDONALD: Can I stop you there for a second.

7 MR. NIXON: Uh-huh.

8 JUDGE MacDONALD: To make sure we are all on the correct page
9 with you.

10 MR. NIXON: Sure.

11 JUDGE MacDONALD: Looking through what the Examiner had
12 said, and what you have also said in your specification, it looks like the prior
13 art taught the process up to that point with respect to substituting a group ID
14 for the individual actual calling party ID.

15 Because you said in your specification that was one of the things -- at
16 the end of the specification you indicated you wanted to substitute a group
17 ID yourself. And that is what the prior art had shown.

18 Now we move into the part of the claim where you feel it
19 differentiates.

20 MR. NIXON: Well, actually, I feel that this part differentiates as
21 well, for reasons that I will explain. But this particular part of the claim
22 requires that the consistent CLI also enables calls to be delivered to the party
23 associated with the simulated CLI by use of translation tables which hold
24 information as to the identity of that party, and their current recorded
25 location.

1 And that is, I think, as you have correctly noted, the returning call,
2 where the DNIS uses the CLI that it received when the incoming call lit, that
3 comes back then to the CTI, looks up in Table 54C and finds out that, oh,
4 yes, 800800 is associated with Bob, which is the consistent permanent
5 identity.

6 Going backward, still through Table 54B, we find out that Bob is
7 associated at this moment with a particular workstation, and so we send the
8 phone call to Bob at that particular workstation.

9 JUDGE MacDONALD: Now, where are those steps, though? In the
10 claims?

11 MR. NIXON: The steps in claim -- let's see.

12 (Pause.)

13 MR. NIXON: Claim 4, for example, is one where it is explicitly
14 called out. I think claim 1, as you pointed out, in the last few lines at least,
15 require that ability.

16 JUDGE MacDONALD: Well, that was my concern. I don't see that it
17 requires any particular functions in there. To me I am reading it, and it looks
18 to be an intended future use of the system. And I am not seeing specific
19 steps being recited in this method claim that allows that return phone call.

20 And I agree with your -- the conclusion that you are trying to reach,
21 which is the prior art doesn't show that particular functionality, but I don't
22 see it in the claim, either, is the concern I have. And I didn't see it in the
23 dependent claims, in addition to that.

24 So, I don't know that you need to convince us that the prior art fails to
25 teach that feature. I think you need to convince us that it's in the claims.

1 MR. NIXON: I got you. Okay. Well, perhaps we need to amend the
2 claims to be more specific, then. But we had believed that was in the claim
3 and that the Examiner's last action, for example, admitted that Staples does
4 not specifically teach or suggest translating the obtained actual calling party
5 identity to obtain a corresponding simulated consistent calling line identity,
6 permanently associated with the calling party.

7 So we felt that there was -- there is an admission that the prior art,
8 Staples, does not teach that, which is quite a bit of what actually I tried to
9 highlight in yellow on one of the charts here.

10 The fact that that actually accounts for a great part, in my view
11 anyway, of claim 1, for example.

12 To supply that, we go to Gruchala. But Gruchala does not teach the
13 use of a consistent -- even for a group -- identity. Gruchala teaches a
14 security feature, for example, where you can block that and some other
15 anonymous identifier, as a --

16 JUDGE MacDONALD: But isn't that in addition to the teaching the
17 Examiner is relying on? I didn't read those as exclusionary. I just read those
18 as here's two possible things that can be done.

19 MR. NIXON: Well, I don't believe that we have claimed using a
20 group identity. We have claimed using an identity that corresponds to a
21 party. A party.

22 And I think that the common understanding of that -- a party -- and I
23 actually looked up last night on the internet -- if you go to Wikipedia, you
24 will find definitions of calling party and called party, and it refers to the
25 calling party, also called "caller", "call originator" or "a party", is a person,
26 etc.

1 So, I think that's what we intended to claim, and I think that is what
2 we did claim when the claim is properly construed through the eyes of those
3 having skill in the art.

4 JUDGE JEFFERY: Another question regarding that, the secondary
5 reference. The Gruchala reference. It does indicate -- I'm in column 3,
6 basically looking at the passages the Examiner cited. Column 3, beginning
7 at line 39.

8 I mean, it seems to me that it indicates that the calling party identifier
9 is converted to a group identifier.

10 MR. NIXON: Yes. I agree.

11 JUDGE JEFFERY: Part of that.

12 MR. NIXON: Yes. I agree. The difference there is it's not converted
13 to a consistent party identifier. It's a consistent group identifier. So, you
14 still can't get the callback to the individual party.

15 JUDGE JEFFERY: But what if you have a situation -- now, this is
16 dealing with a corporate entity, as I understand it, from the background
17 reference.

18 What if you have, say, a closely held corporation with one person as
19 the corporation. And that one person wants to have an alias, if you will.
20 They want to use their home phone and their personal calling ID, but they
21 want to have it billed, let's say, to the corporate account.

22 Could you not have a situation where that would in fact be associated
23 with a particular person?

24 MR. NIXON: Yes. If you define the group as one, then, of course,
25 that is true. But I don't believe that is the teaching of the reference
26 that -- with hindsight, one can construe it that way, if one wishes to. But I

1 don't think the reference itself teaches defining the group as one. It's to the
2 contrary.

3 Then there's also the alternative, that the individual, whether it's one
4 or many in a group, has the power to change that. So it's not a consistent
5 calling line identity that results. It could be one associates with a group or it
6 could be one that is anonymous, depending.

7 So there is no control -- the system itself has no way to ensure that the
8 outgoing CLI is always going to consistently identify even a group. So I
9 think that is contrary.

10 And then the third reference, the tertiary reference, to Kahn, actually,
11 I think, teaches away from the claim that it was used for, where we have an
12 in-calling CLI that is used to then return the call. But in Kahn, the callback
13 number has to be dialed in by the calling party -- that is, the call-in party has
14 to dial in the number. So there is no use of the CLI to determine the
15 callback number. So, it's actually contrary to what is required by the rejected
16 claim.

17 It seems to me that the idea of having flexible assignments of people
18 to workstation and yet being able to locate them and get the telephone call
19 going back to that particular person is not there in these pieces of prior art
20 and I understand what Judge MacDonald is saying, that he doesn't see it yet
21 in the claim, either.

22 JUDGE LUCAS: The claim seems to go back to the -- what your
23 Figure 6 and Figure 7, when you first crafted it. The claim seems to go back
24 to the various tables.

25 MR. NIXON: Yes.

1 JUDGE LUCAS: Just -- you are claiming that through the use of
2 tables, you can associate the -- well, the call line identity with the real name
3 and their current location.

4 MR. NIXON: Yes. I believe one way of looking at claim 1, for
5 example, is that it is a double translation. And the intermediary between the
6 two tables, for example, is at least two tables. And the intermediary is the
7 real actual identity of a person, a calling party. And it is identified by names
8 here.

9 So that you have that real person identified in the middle of these
10 translation tables. So, it's a double translation and somewhere in the middle
11 of the translation process, we have the actual calling ID of a person, a party,
12 Steve or Tom or Bob, so that we can get back to that particular person, no
13 matter where they change their location within the organization, by
14 workstations, or even outside the organization.

15 Staples, on the other hand, is primarily, I think exclusively, concerned
16 with remote workers. And wants to have a virtual presence for them within
17 the corporate environment. Wants to make it appear as if they are there in
18 the corporate environment. Even go so far as to route all of the calls that
19 were made to the home number -- to route them all to or from the home
20 number -- to route them all through the virtual presence server, which is at
21 the corporate location. So, you are still stuck with the conventional
22 mentality, where a person is associated with one extension number and one
23 particular office, rather than having two dynamic translation tables where the
24 real identity of a person is changed from time to time, as need be, to
25 correspond to the real location of that person so that you can right the right
26 telephone.

1 JUDGE MacDONALD: One other point. You mentioned, I think,
2 several things so far, but you started to talk, I think, about claim 6. And I
3 did want to get into the record your comments on that because I was
4 concerned by what I saw in the brief.

5 MR. NIXON: Well, I don't think that Kahn -- I think this is where
6 Kahn is cited -- Kahn actually requires one to dial in the callback number.
7 Claim 6 actually requires that you read the preceding claims here. It
8 requires that you have captured the CLI, clear down the incoming call, and
9 then you make a callback to the calling party based on the calling line
10 identity of that incoming call. And then join the calls.

11 JUDGE MacDONALD: Yes. What I was concerned about in the
12 brief was that you took claim 6 to be referring to the reverse phone call back
13 to the called party -- I'm sorry. Back to the calling party from the called
14 party. And that wasn't what was disclosed in the specification. Rather, it
15 was an alternative of what is shown in the first three steps in claim 1 of how
16 that would actually occur when the first phone call was made from the
17 calling party to the called party.

18 And it is discussed in the amended specification --

19 MR. NIXON: I think actually looking right here on the spot -- I think
20 you are correct because claim 4 does refer back to the first step of claim 1.
21 And claim 5 adds to that, and then claim 6 adds to that.

22 JUDGE MacDONALD: Right. And I thought the Examiner actually
23 in fact had gotten that tertiary reference dead-on, but this was a situation
24 where the company wanted to have all the calls, even from the beginning,
25 controlled from within, so that you weren't using your home service to make
26 the company call. You would let them know what your number was, then

1 you would hang up and they would call you back and call the party you
2 wanted to get to, in setting up the initial call.

3 The alternative was described several times in the specification.
4 That's why I thought that it was not --

5 MR. NIXON: I think you are correct on that, actually. Yes. Right. It
6 looks like we may have to go back and add some more claims here.

7 (Laughter.)

8 JUDGE LUCAS: Your problem -- the tabling that is so crucial to that
9 third part of your first claim --

10 MR. NIXON: Right.

11 JUDGE LUCAS: -- I'm sure he would be upset if I mentioned,
12 Gruchala. Gruchala?

13 MR. NIXON: I have had several pronunciations of my own.

14 JUDGE LUCAS: We'll have to phone him and ask how to pronounce
15 his name.

16 Has -- you know, in his various columns and so forth, a whole bunch
17 of tables, jumping from location to access codes and access codes to line
18 identities and so forth, why are you unhappy with Gruchala being cited for
19 that -- for the various tabling that's recited in claim 1?

20 MR. NIXON: Well, I mean, we are not claiming to be the first to
21 have translation tables. These are translation tables that have in the middle
22 of the process the actual identity of a party.

23 JUDGE LUCAS: Right.

24 MR. NIXON: And that's -- I don't believe that happens in Gruchala.
25 Gruchala -- I'm sorry about mispronouncing it.

26 JUDGE LUCAS: He's not here.

1 MR. NIXON: Gruchala has, I believe -- it's teaching is that it should
2 be a group. Now, if you collapse a group into one person, then I suppose
3 that could be viewed as a party. But I don't read that from my own reading
4 of this reference. I don't see that that's taught in this reference.

5 To the contrary, I want you to believe that the ID is associated with a
6 group of people.

7 JUDGE LUCAS: All right. I see your point. That is to say, I
8 understand your point.

9 MR. NIXON: I understand you, too.

10 JUDGE LUCAS: By the way, Gruchala is a female, it turns out.
11 Carol Gruchala.

12 MR. NIXON: Okay.

13 JUDGE LUCAS: Never met her.

14 JUDGE MacDONALD: But I want to clarify what I saw when I went
15 through here. Several points you have made in your arguments that you
16 thought were in the claim -- I, of course, disagree as to them being there. I
17 didn't see it explicitly in the references, the one-to-one aspect.

18 MR. NIXON: Right. If we could rewrite the claim right here on the
19 spot, I would be happy to do it, but unfortunately, I don't think the process
20 works that way.

21 JUDGE MacDONALD: No. No.

22 MR. NIXON: But we intended to have the claim be specific to
23 requiring the return call to go to the right person, because that is the utility of
24 it, actually, is to have the returning call come back to the right person,
25 wherever that person might be at this moment, which could be different than
26 where the person was when the call was first placed.

1 JUDGE MacDONALD: Right. There was quite a bit of discussion
2 about how to get that information into the system. So that clearly was in the
3 specification.

4 MR. NIXON: Right. I think I'll go back and draft some more claims.
5 (Laughter.)

6 JUDGE MacDONALD: Okay.

7 JUDGE LUCAS: It's still within the PTO, so you have that option.

8 MR. NIXON: I understand. An RCE and some claims.

9 (Laughter.)

10 JUDGE MacDONALD: Is there any other points that you wanted to
11 make today?

12 MR. NIXON: No. I think we have touched on them all, and I think it
13 has been a quite helpful exchange. I thank you very much for sharing with
14 me your frank feeling about the claim because it does give me a good idea
15 now as to where I should be going with respect to some additional claims,
16 some new claims, some amendments.

17 JUDGE MacDONALD: Okay. Thank you.

18 (Whereupon, at 11:20 a.m., the hearing was concluded.)